

## REMARKS/ARGUMENTS

In the Office action dated July 20, 2005, the Examiner finally rejected claim 7, the only claim in this Application, under 35 U.S.C. § 103(a), as being unpatentable over U. S. Patent No. 5,319,867 to Weber in view of Applicant-supplied document entitled "PORON 90, The Ultimate in Cushioning."

In the Specification, no changes

In the Claims, a new claim 8 is presented.

### **The Invention**

The invention is a shoe insole which incorporates a low-rebound cushioning layer and a moisture wicking fabric material.

### **The Applied Art**

The Technical Report for PORON 90 describes the material Applicants use for the low-rebound cushioning layer of their invention.

U. S. Patent No. 5,319,867 describes a multi layer shoe insole which reduces transfer of static electricity.

### **The Claims**

Claim 7 requires that cushioning layer 12 be:

*fully responsible for all cushioning behavior in the insole, structurally limited, with regard to cushioning-action response by it to a load-induced deformation, solely to a non-spring-back response, with said cushioning layer structure having upper and lower surfaces, and being formed throughout of an acceleration-rate-sensitive, viscoelastic, non-springy cushioning material....*

The Examiner combine Applicant-supplied technical data for PORON 90 and '867, and insists that this combination results in Applicants' invention, going so far to state, on page 2 of the Office action, that Rogers (the PORON 90 Technical Data) teaches an insole made of the PORON 90 material. In fact, There is no teaching nor suggestion in any of the PORON 90 Technical Data that the material be combined or laminated with any other material, nor used in a shoe insole. The Examiner's conclusion is based solely on Applicants' teaching - not on the applied art.

The Examiner further contends that '867 teach a combination of a wicking fabric with ANY cushioning material, when this is simply not the case. '867 suggests that the desired compression set ranges from about 1% to about 50%, according to ASTM Standard D1667-76, and prefers a range of about 5% to about 15%. Col. 3, line 65 to col. 4, line 5. PORON 90 has a compression set, as measured according to ASTM Standard 1667 of less than 5%, in any of the PORON 90 Series products. Thus, were in the inventor of '867 selecting a product for use in the conductive shoe sole of the invention, he would not select any of the PORON 90 Series products, as the compression set of those products is too low to fit within the preferred compression set parameters.

The Examiner's comments regarding the use of the words "springy" and "resilience" is noted, however, the attached copy of pages from a 1960 version of Webster's New World Dictionary clearly establishes that the Examiner's position is wrong: resilience and springy are equivalent terms, therefor, non-resilient and non-springy are also equivalent terms. The Examiner is correct that '867 requires the cushioning layer to be resilient, or springy. Applicants teach away from the teaching of '867, thus rendering the combination of the PORON 90 material

and a fabric wicking layer non-obvious. Claim 7 is therefore allowable over the applied art.

New claim 8 incorporates the limitations of claim 7 and further requires that the cushioning material conform to a wearer's foot, as described in the Specification, page 3, line 20 to page 4, line 2. This characteristic of Applicants' invention is neither taught nor suggested by '867, nor by the PORON 90 technical data, but is the result of the combination of layers as taught and claimed by Applicants. Claim 8 is allowable over the applied art.

Applicants submit herewith a Declaration under MPEP § 716.03, wherein an officer of the owner of the instant Application provides information regarding the commercial success of the product claimed in the Application. Since the beginning of commercial sales of the product, in September, 2000, (which is less than one year prior to the filing of a U.S. Provisional Patent Application from which this Application claims priority) in excess of 21,000 pairs of insole constructed according to the invention have been moved in commerce. This product represents a retail value in excess of \$600,000.00. This volume of product would not have been commercially successful but for the unique properties obtained by Applicants through the combination of materials described and claimed in this Application. If the Examiner's obviousness rejection were well taken, given the length of time that '867 and the PORON material have been available, it would seem that others would have seen the benefits of the combination of materials long before Applicants, however, there is no evidence, and no known commercially available product, other than Applicants', which meets the needs of the marketplace as well as does Applicants' insole, which supports Applicants' contention that their invention is novel, non-obvious, and commercially successful.

In light of the foregoing amendment and remarks, the Examiner is respectfully requested to reconsider the rejections and objections state in the Office action, and pass the application to allowance. If the Examiner has any questions regarding the amendment or remarks, the Examiner is invited to contact the undersigned.

**Request for Extension of time in Which to Respond**

Applicants hereby request an extension of time under 37 C.F.R. § 1.136. A PTOForm 2038 Credit Card authorization is enclosed to pay the requisite extension fee. The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any over-payment to Account No. 22-0258.

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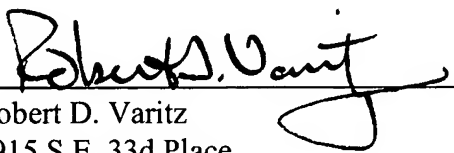
Respectfully Submitted,

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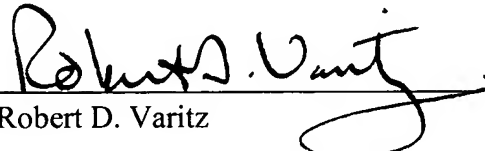
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P.O. Box 1450  
Alexandria, Virginia 22313-1450

  
Robert D. Varitz

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